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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/771,355 | 01/26/2001 | David A. Zarling | A-68872-1/RFT/RMS/BTC | 6076 |

7590

10/02/2002

FLEHR HOHBACH TEST
ALBRITTON & HERBERT LLP
Four Embarcarero Center, Suite 3400
San Francisco, CA 94111-4187

EXAMINER

LAMBERTSON, DAVID A

ART UNIT

PAPER NUMBER

1636

DATE MAILED: 10/02/2002

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/771,355²

Applicant(s)

ZARLING ET AL.

Examiner

David Lambertson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) ____ is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 1-18 is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-18 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application):
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s) ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-9, drawn to a method for inhibiting tumor cell proliferation using an antisense Rad51 inhibitor, classified in class 514, subclass 44.
- II. Claims 10-15, drawn to a method for inhibiting tumor cell proliferation using a small molecule Rad51 inhibitor, classified in class 514, subclass 42.
- III. Claims 16 and 17, drawn to a method for inhibiting tumor cell proliferation using a peptide Rad51 inhibitor, classified in class 514, subclass 2.
- IV. Claim 18, drawn to a method for sensitizing tumor cells to radiation using Rad51 inhibitors, classified in class 424, subclass 9.2.

The inventions are distinct, each from the other because of the following reasons:

Inventions Groups I-III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different functions. The method for inhibiting tumor cell proliferation using an antisense Rad51 inhibitor (Group I), method for inhibiting tumor cell proliferation using a small molecule Rad51 inhibitor (Group II) and method for inhibiting tumor cell proliferation using a peptide Rad51 inhibitor (Group III) are unrelated because each inhibitor is a different

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molecule with different structures and functions. Therefore, a search of one group would not be co-extensive with the search of another hence said search would be burdensome.

Pursuant to 35 U.S.C. 121 and 37 C.F.R. 1.141, the sequences listed in claim 9 are subject to restriction. The Commissioner has partially waived the requirements of 37 C.F.R. 1.141 and will permit a reasonable number of such nucleotide sequences to be claimed in a single application. Under this policy, a single independent and distinct nucleotide sequence will be examined in a single application.

Claim 9 specifically claims antisense SEQ ID NOS 4-9, which are targeted to and modulate the expression of Rad51. Although the antisense sequences each claim the same target and modulate the expression of the same respective gene, the instant antisense sequences are considered to be unrelated since each antisense sequence claimed is structurally and functionally independent and distinct for the following reasons: each antisense sequence has a unique nucleotide sequence and each antisense sequence targets a different and specific region of a respective gene (as indicated above). Furthermore, a search of more than one (1) of the antisense sequences claimed presents an undue burden on the Patent and Trademark Office due to the complex nature of the search and corresponding examination of more than one (1) of the claimed antisense sequences. In view of the foregoing, one (1) antisense sequence is considered to be a reasonable number of sequences for examination. Accordingly, applicant is required to elect one (1) antisense sequence when electing Group I as set forth above.

Inventions Groups I-III and Group IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of

operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation. The method for inhibiting tumor cell proliferation using an antisense Rad51 inhibitor (Group I), method for inhibiting tumor cell proliferation using a small molecule Rad51 inhibitor (Group II) and method for inhibiting tumor cell proliferation using a peptide Rad51 inhibitor (Group III) are unrelated to a method for sensitizing tumor cells to radiation (Group IV) because the methods involve different, unrelated steps. Therefore, a search of one group would not be co-extensive with a search of the other hence said search would be burdensome.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, and so on, restriction for examination purposes as indicated is proper.

A telephone call was made to Steve Landeras on July 24, 2002 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David A Lambertson whose telephone number is (703) 308-8365. The examiner can normally be reached on 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Irem Yucel can be reached on (703) 305-1998. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3014 for regular communications and (703) 305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

David A. Lambertson
August 1, 2002

DAVID GUZO
PRIMARY EXAMINER
